Double Patenting

All pending claims in this application have been rejected under the judicially-created doctrine of double patenting over claims 1-18 and 22-39 of U.S. Patent No. 5,068,734 (Reexamined). The '734 patent is commonly-owned by the Applicant of the present application, Jack Beery.

A terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) is being submitted in this application.[1] The disclaimer is believed to overcome the double patenting rejection.

Reissue Declaration Issues

The Examiner has also rejected claims 5[2], 7-19, 21-28 and 30-56 on the basis that the reissue declaration filed on April 15, 1996 is defective.

A new declaration by the applicant Beery has been submitted herewith. Additionally, a declaration is submitted by Thomas A. Boshinski, applicant's undersigned representative who prepared and prosecuted the applications for the '947 patent (the patent sought to be reissued in this application) and applicant's '734 patent. As explained in detail below, these declarations particularly specify the actual errors in the patent, and establish how and when the errors arose and how and when the errors were discovered.

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[1]This present response is being filed with the Office by way of fax transmission. However, the terminal disclaimer requires payment of a fee, which payment will be made by check. Accordingly, the terminal disclaimer is being submitted by mail as a "Supplemental Response" to the outstanding Office action.

[2]The Examiner's rejection does not include claim 5, but it is believed to be clear from the accompanying comments that this claim was intended to be included.

The errors in the '947 patent arose as the result of applicant and his attorney failing to appreciate the full scope of the claims which would have been available to applicant.[3] In the Office action, the examiner has helpfully categorized the various errors which occurred during the preparation and prosecution of the application for the '947 patent:

A. "I did not realize that my invention also encompassed the method in accordance with which the device operated."

B. "I overlooked the fact that it was not necessary to include the tuner means of the television receiver as an element in the claims, since the device could be constructed as a remote device which relied upon the television's own tuning means."

C. "I invented various other television control features, among them being a system wherein the operator may selectively assign desired channels in a desired order into a cue or into a scroll sequence, or wherein the operator may assign selected channels into two or more independent cues or scroll sequences for channel selection. However, because I assumed such features would all be incorporated into a single remote control device, these features were erroneously claimed only in combination with the operator-selected channel designation feature. In fact, these features should have also been claimed independently."

D. "I also did not utilize certain alternate claim language to that actually used in the claims of the '947 and reexamined '734 patents."

E. "I did not claim my invention, with respect to the actions of the processor, using the alternate language 'in response to' instead of 'upon receipt of' with regard to various input signals to the processor."

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[3]In the Office action, the Examiner characterizes the applicant's asserted error as the failure to "fully understand [the] invention disclosed in the specification and defined in the claims." Office Action dated March 30, 1997 at page 4 (hereinafter cited as *"OA at 4"*). However, applicant has never stated that he did not understand the invention, nor that he did not understand the contents of the application for the '947 patent. Rather, he states that he erroneously did not appreciate that broader claims and/or alternative claims were available.

> [F1.][4] "I also erroneously did not claim my invention using the alternate language 'tuner' for 'tuner means', 'memory' for 'memory means', 'operator-actuated control device' for 'operator-actuated control means', and 'processor' for 'processor means'...."
>
> [F2.] "I also erroneously did not claim my invention using ... the alternate language 'channel code' for 'channel tuning designation' and 'select code' for 'channel select designation'...."
>
> [F3.] "I also erroneously did not claim my invention using ... the alternate language wherein the 'channel tuning designation' is defined as being 'in a first series', and the 'channel select designation' is defined as being in a second series."

Each of the above-identified errors will be discussed in turn, and the relationship of each error to the various claims of the reissue application will then be summarized.

Errors A, B and C

All of Errors A, B and C resulted from the failure of applicant and his attorney to appreciate the full scope of the invention which could have been claimed. With respect to Error A, the applicant states

> At the time the applications for both the '734 and '947 patents were prepared and prosecuted, I incorrectly concentrated too narrowly (as I now realize) on an apparatus for use as a television controller, and specifically wherein the controller had the ability to assign operator-selected channel designations for use in selecting television channels.
>
> As a result, I did not realize that my invention also encompassed the method in accordance with which the device operated. I did not discuss the possibility of presenting method claims in the applications for the '734 and '947 patents with Thomas A. Boshinski, the attorney who represented me throughout the preparation and prosecution of the applications. *Declaration of Jack Beery at ¶¶ 14-15 (hereinafter cited as "JB at 14-15").*

Applicants' attorney declares that he too did not appreciate that a method claim could have been presented, and corroborates applicant's statement that the subject was not discussed:

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[4]As discussed with the Examiner at the interview, the examiner's "error F" incorporates several aspects to which differing comments may apply. For ease of discussion, the error has been divided into errors F1, F2 and F3.

> During the preparation and prosecution of the applications for the '734 and '947 patents, it did not occur to me that the Beery invention could or should be expressed in terms of a method. Beery and I never discussed the possibility of including method claims in either application. No method claims were ever drafted, nor were any such claims presented. Throughout the preparation and prosecution of the applications, my discussion with Beery regarding the invention and the specification and claims was in terms of a device. *Declaration of Thomas A. Boshinski at ¶5 (hereinafter cited as "TB at 5").*

For Error B, applicant states that he overlooked the fact that a "tuner means" was not a necessary limitation. *JB at 15.* He did not discuss whether this limitation was necessary with his attorney:

> I did not discuss whether the tuner means was a necessary claim limitation with Mr. Boshinski during the preparation or prosecution of applications for the '734 and '947 patents. *Id.*

His attorney corroborates the lack of discussion of this point, and further explains why the possible elimination of the tuner means from the claims did not occur to him:

> Beery and I never discussed the possibility of including claims in either application which did not include this element. No such claims were ever drafted, nor were any such claims presented. During our discussions of the invention, the invention was regarded as of interest to, and it was expected that any commercial embodiment would be manufactured for and sold by, manufacturers of televisions, videorecorders and the like, whose products would include tuners. *TB at 6.*

For Error C, applicant states that:

> At the time the applications for both the '734 and '947 patents were prepared and prosecuted, I incorrectly concentrated too narrowly (as I now realize) on an apparatus for use as a television controller, and specifically wherein the controller had the ability to assign operator-selected channel designations for use in selecting television channels. *JB at 14.*
>
> ...
>
> ... I invented various other television control features, among them being a system wherein the operator may selectively assign desired channels in a desired order into a cue or into a scroll sequence, or wherein the operator may assign selected channels into two or more independent cues or scroll sequences for channel selection. However, because I assumed such features would all be incorporated into a single remote control device, these features were erroneously claimed only in combination with the operator-selected channel designation feature. In fact, these features should have also been claimed independently. However, I did not recognize the possibility of presenting such claims,

> nor did I discuss this possibility with Mr. Boshinski during the preparation or prosecution of the applications for the '734 and '947 patents. *JB at 16.*

Applicant's attorney states that through oversight, it also did not occur to him that these features set forth in dependent claims could be the subject of independent claims. He also corroborates the lack of discussion on this point:

> Beery and I never discussed the possibility of including claims in either application which did not include these elements. No such claims were ever drafted, nor were any such claims presented. I erroneously concluded that any apparatus constructed in accordance with the Beery invention would include a controller that had the ability to assign operator-selected channel designations for use in selecting television channels. *TB at 7.*

Thus, the declarations clearly establish *how* the Errors A, B and C occurred: through the inadvertent failure of applicant and his attorney to appreciate the true scope of the invention. While the Examiner in the Office Action questions how a registered patent attorney could have failed to realize that such claims could have been presented, *OA at 5-6,* the case law clearly recognizes that errors of this type can and do occur. "An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents." *In re Wilder,* 222 USPQ 369, 371 (CAFC 1984). Such error supports a broadening reissue application. "[A] broadened reissue has generally been founded upon post-issuance discovery of attorney error in understanding the scope of the invention." *In re Amos,* 21 USPQ2d 1271, 1273 (CAFC 1991).

Often, errors of this type arise when unnecessary limitations have been included in the claims, as in Errors B and C in the present application. Such was the fact situation presented in *Wilder, supra*. However, the error can also be the failure to present claims of a different category, as in Error A in this application. *See, e.g., Scripps Clinic v. Genentech, Inc.,* 18 USPQ2d 1001, 1008-09 (CAFC 1991), where the error was the failure to include product claims in a patent containing only process and product-by-process claims.

Moreover, whether the errors could have been avoided is immaterial. As stated by the CAFC in *Scripps Clinic,* 18 USPQ2d at 1009, "[t]he law does not require that no competent attorney or alert inventor could have avoided the error sought to be corrected by reissue."

With regard to the question of *when* the Errors A, B and C occurred, and as discussed at the interview, it is not possible with errors of the type on which this application is based to precisely specify a date upon which the errors occurred. Because the errors effectively occurred throughout the preparation and prosecution of the applications for the '734 and '947 patents, *JB at 13, TB at 5-18,* the errors were in essence "ongoing" errors. As the examiner will appreciate, it is not possible to be more specific on this point. See, e.g., *Wilder* or *Amos, supra,* for similar fact situations where reissue was permitted.

With regard to the discovery of Errors A, B and C, the Beery and Boshinski declarations establish how and when these errors were discovered. Both applicant and his attorney, during the period from January to March of 1993, had closely reviewed the '734 and '947 patents as a result of their discussions with possible trial counsel and as a result of the reexamination of the '734 patent which was then in prosecution. For Error A, the trial counsel candidates suggested generally that method claims would be desirable in connection with the anticipated litigation, and that such claims could have been obtained. Applicant and his attorney recognized that this was so, and hence, during this period, it was discovered that there was error in the '947 patent in that Applicant had claimed less that he had a right to claim. *JB at 26-27; TB at 23.* However, at this time, the errors had not been precisely identified, in the sense that the claims which were to be presented in a reissue application had not yet been determined. *TB at 23.*

As set forth in the Boshinski declaration, claims 5-10, which were originally presented in the reissue application as filed, were drafted along with the reissue application papers during the summer of 1993, approximately during July and August. *TB at 25.* Method claim 5 was drafted to address Error A, as it was determined by Boshinski that this claim could have been presented in the application for the '947 patent but was not. Later, during the prosecution of the present application, and as set forth in the Boshinski declaration, the drafting of responses to office actions led to the discovery of other claims which could have been presented in the original application for the '947 patent. *TB at 32-33.* Again with specific regard to Error A, a summary judgment hearing in litigation in October 1994 revealed that other method claims should have

been presented in the '947 application. During preparation of an amendment to this application in November and December of 1994, method claims 55 and 56 were drafted and submitted. *TB at 34-35.*

How and when Error A was discovered is thus clearly described in the declarations. Similar fact chronologies have been found sufficient by the CAFC to support reissue applications, see, e.g., *Wilder* and *Amos, supra.*

Similarly, Error B was first discovered during the period of January through March 1993, when through discussions with trial counsel candidates, it was suggested and applicant and his attorney recognized that claims could have been presented in the application for the '947 patent in which a "tuner means" was not one of the claim elements. *TB at 23.* One specific claim which corrects this error, claim 7, was drafted during July and August 1993 as the reissue application papers were prepared. *TB at 25.* The claims were again reviewed by applicant and his attorney when replying to the initial office action, and in drafting the response during March through August 1994, it was discovered that claims 11-15, but for Error B, could have been presented in the '947 application. It as also discovered that claims 17, 23-27, 30, 33-36 and 39 could also have been presented but were not, due in part to Error B. *TB at 27.* Finally, while drafting a further response to an office action in November and December 1994, it was discovered that claims 49-54 could have been presented in the '947 application but were not, due in part to Error B. *TB at 32.*

Thus, the time and manner in which Error B was discovered is set forth with adequate specificity in the declarations.

Error C was first discovered in about March 1993. Applicant's attorney recognized that claims could have been presented in the application for the '947 patent in which limitations related to the "channel select designation" were not included as claim elements, but erroneously had not been. *TB at 24.* Several claims which correct this error, claims 8 and 9, were later drafted

during July and August 1993 as the reissue application papers were prepared. *TB at 25.* The claims were again reviewed by applicant and his attorney when replying to the initial office action, and in drafting the response during March through August 1994, it was discovered that claim 16, but for Error C, could have been presented in the '947 application. It was also discovered that claims 21-22, 28, 31-32, 37, 42-43 and 45-47 could also have been presented but were not, due in part to Error C. *TB at 27.*

Thus, the time and manner in which Error C was discovered is set forth with adequate specificity in the declarations.

Error D

Errors D, E and F1-F3 pertain to claim language which has been described in the supporting declaration as "alternate language". *JB at 17.* As discussed at the interview, "Error D" identified by the Examiner in the Office action is in fact an "umbrella" statement which summarizes the nature of Errors E and F1-F3. Each of these latter errors will be discussed below in turn, and Error D will not otherwise be dealt with.

Error E

Error E pertains to applicant's failure to present sufficiently broad language with respect to the expression originally appearing in the claims as "upon receipt of". To the extent that this terminology implies immediacy in the carrying out of subsequent steps by the processor, it is unnecessarily narrow. As explained by applicant,

> I did not claim my invention, with respect to the actions of the processor, using the alternate language "in response to" instead of "upon receipt of" with regard to various input signals to the processor. *JB at 17.*

Applicant's attorney also states that through oversight he did not include such claim language, and that no discussions with Beery on this point ever took place. *TB at 8.*

This error is properly the subject of a reissue application. Although characterized by applicant as a "failure to utilize alternate language," it represents a failure to present sufficiently broad claim language and is similar to Errors A, B and C. The error occurred through inadvertence, and is properly presentable in this application for similar reasons.

As with the preceding errors, this error occurred in an "ongoing" manner throughout the preparation and prosecution of the applications for the '734 and '947 patents. *JB at 13; TB at 8.*

The time and manner in which this error was discovered is set forth in the declarations. As explained in the Boshinski declaration, approximately in early 1994, the defendant in the litigation which applicant was prosecuting in connection with the '734 patent suggested that the accused device did not fall within the claim language "upon receipt of." This was allegedly because defendant's device received input signals for some of its operations from its operator-actuated control means, but the processor did not carry out the instructions until sometime later. While applicant's attorney did not then, and does not now, believe that the argument advanced by defendants was correct, applicant and his attorney nonetheless recognized that broader claim language could have been presented in the '947 patent. *TB at 28.* The specific language reflected in claims 17-19, 21-28 and 43 was developed during about March through August 1994 as a response to an outstanding office action in this application was prepared. These claims were drafted, in part, to correct Error E. Also, while drafting a further response to an office action in November and December 1994, it was discovered that claims 49-52 could have been presented in the '947 application, but were not, due in part to Error E. *TB at 32.*

Thus, the time and manner in which Error E was discovered is set forth with adequate specificity in the declarations.

During the interview, the Examiner questioned whether claim language "in response to" would be properly supported by the specification. In this regard, the Examiner is referred to column

13, lines 48-60 where it is explained that in one embodiment of the invention, delayed programming of the memory may take place where the first data stream is supplied through the cable service. The programming may take place at either a predetermined time interval, or upon receipt of a specific instruction. Further, in column 14, lines 13-37 a further alternate embodiment is described in which the first data set comprising the programming information is received and then used to program memories in any number of other remote control devices or television receivers. In such a case, a time delay exists between when the data set is received by the controlling processor and when the data is in fact stored in memory. These examples illustrate that the specification contemplates a time delay between receipt of data and subsequent action.

Also, at column 14, lines 42-48, it is explained that the disclosed invention may be used within a videorecorder. Such devices provide as one of their principal functions the delayed recording of television broadcasts. Thus, in practicing the invention in this embodiment, a time delay exists between receipt by the processor of the second data set and subsequent tuning of a television channel.

Support exists in the specification for claim language which encompasses such delayed response.

Error F1

Error F1 pertains to the inclusion in all of the claims of the '947 and '734 patents of claim elements expressed in terms of "means for" language. By not including some claims which did not use the expression "means for", applicant erroneously failed to claim the invention sufficiently broadly. *TB at 9, 31.* (See further discussion, *infra.*) As explained in the attorney's declaration, the significance of such claims was not appreciated at the time the applications for the '734 and '947 patents were prepared and prosecuted. *TB at 31.* Thus, the error occurred during this period of time.

As also explained in the attorney's declaration, *Id.*, the Error F1 was discovered during 1994 as a result of the CAFC decision in *In re Donaldson,* 29 USPQ2d 1845 (1994). In its decision, the CAFC required that the PTO apply the "equivalents" analysis mandated by 35 USC 112, sixth paragraph, to its consideration of claims for patentability under sections 102 and 103. As a result of that decision, and subsequent discussions with applicant's trial counsel and other professional colleagues, applicant's attorney realized that the claims of the '951 and '734 patents were unnecessarily limited. *TB at 31.*

In the office action, the Examiner has suggested that the claims presented in this application which eliminate reference to "means for" are actually of *narrower* scope than the original claims. *OA at 8.* In fact, the reverse is true. "Means" limitations in claims are restricted in scope to the structure disclosed in the specification and equivalents thereof, while other limitations are not. *See, Greenberg v. Ethicon Endo-Surgery Inc.*, 39 USPQ2d 1783, 1785 (CAFC 1996).

Thus, for example, original claim 1 of the '947 patent sets forth

> memory means for storing at least one operator-assigned channel select designation for at least one of said tuning designations,

while claim 30 of this application recites

> a memory for storing at least one operator-assigned channel select designation for at least one of said tuning designations.

Claim 1 is limited by the section 112(6), and is confined to the specific forms of memory set forth in the specification and their equivalents. Claim 30 is not, and thus with respect to this limitation, is broader.[5] A similar analysis of the other "means" limitations may be made.

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[5]The exact language "means for" may not always be required to invoke the analysis of section 112, sixth paragraph, MPEP §2181, *Raytheon Co. v. Roper Corp.*, 220 USPQ 592, 597 (CAFC 1983), but at the least raises a presumption that the analysis applies, *Greenberg v. Ethicon Endo-Surgery, supra,* 39 USPQ2d at 1787. In the claim 30 example discussed herein, the language "for storing at least one operator-assigned channel select designation for at least one of said tuning designations" in fact describes the *structure* of the memory. It describes the type of memory that is used by describing its capability, in the same sense that "a beam capable of supporting a two-ton load" describes not the function of the beam but rather its structure.

The fact that Error F1 could perhaps be characterized as "legal" error, rather than factual error, does not preclude this error from being correctable by reissue. As noted by the CAFC in *Scripps Clinic v. Genentech Inc., supra,* 18 USPQ2d at 1009, "[a]n error of law is not excluded from the class of error subject to correction in accordance with the reissue statute." Thus, Error F1 is a proper error for correction by reissue.

As noted above, Error F1 was discovered in 1994 as a result of applicant's attorney learning of the *Donaldson* decision, and discussing its import with applicant's trial counsel and others. *TB at 31.* After realizing generally that claims which did not include "means" limitations were erroneously omitted from the application for the '947 patent, applicant's attorney drafted claims 30-37 in about March through August 1994 for the purpose of correcting Error F1. *TB at 32.* These claims were presented in applicant's amendment filed August 18, 1994. Also, while drafting a further response to an office action in November and December 1994, it was discovered that claims 53 and 54 could have been presented in the '947 application, but were not, due in part to Error F1. *TB at 33.*

Thus, the time and manner in which Error F1 was discovered is set forth with adequate specificity in the declarations.

Errors F2 and F3

Errors F2 and F3 both pertain to the addition of claims whose scope is narrower than the original claims, as the examiner correctly notes in the office action. *OA at 8.* The examiner has questioned whether the omission of claims of this type is "error" which can be properly corrected by reissue. *Id.*

The presentation of additional claims *narrower* in scope is not inconsistent with applicant's statement that he "claim[ed] less than Patentee had a right to claim in the '947 patent." *JB at 13.* While omission of claims of the type pertaining to Errors F2 and F3 do not create reissuable error by reason of the patentee having claimed too little in *scope,* it does create error

by "claiming less" in terms of the number of claims. These claims should have been presented to provide a "fall-back" position for applicant in the event his broader claims are later found invalid. *TB at 10-11.*

The CAFC has permitted this approach: "[T]he practice of allowing reissue for the purpose of including narrower claims as a hedge against the possible invalidation of a broad claim has been tacitly approved at least in dicta, in our precedent." *Hewlett-Packard v. Bausch & Lomb,* 11 USPQ2d 1750, 1757 (CAFC 1989), citing *In re Handel,* 136 USPQ 460, 462 n.2 (CCPA 1963). Thus, the Errors F2 and F3 can be cured by this reissue.

These claims were not considered, and thus not presented, during the preparation and prosecution of the applications for the '947 and '734 patents by either applicant or his attorney. *JB at 17; TB at 10-11.* Nor did they discuss the possibility of presenting such claims. *Id.* The claims were omitted through oversight, and the errors occurred, in an ongoing sense, throughout the preparation and prosecution of the applications.

Error F2 was discovered in about early 1994. As part of the work in prosecuting applicant's infringement action referred to above, applicant's trial counsel, along with applicant's attorney Boshinski, carefully reviewed the specifications of the '734 and '947 patents, discussing each of the terms used within the specifications. With regard to the terms "channel code" and "select code", both are defined in the specification at Col. 6, lines 35-38 and 39-41, respectively. Trial counsel observed that although these terms were narrower than those already used in the claims ("channel tuning designation" and "channel select designation"), the terms were not found in any of the claims of the '734 or '947 patents. Boshinski then realized that such claims could have been presented in the '947 application as a hedge. *TB at 29.* Accordingly, when the next amendment in this reissue application was drafted in about March through August 1994, claims 49-52 were added to correct the error F2. *TB at 32.*

Error F3 was also discovered around the early portion of 1994. As a further part of the work in prosecuting applicant's infringement action referred to above, applicant's trial counsel, along with applicant's attorney Boshinski, carefully reviewed numerous prior art citations which were identified by defendants.[6] Trial counsel noted that the fact that the "channel tuning designations" could be defined as being in a "first series" and that the "channel select designations" could be defined as being in a "second series" could be helpful in explaining the manner in which applicant's invention worked, especially when explaining how it differed from the prior art.[7] Boshinski then realized that claims incorporating these terms were not found in either of the '734 or '947 patents, but that such claims could have been presented in the '947 application. *TB at 29.* Accordingly, when the next amendment in this reissue application was drafted in about March through August 1994, claims 53 and 54 were added to correct the Error F3. *TB at 32.*

Other Errors in the Claims

In preparing this response to the outstanding Office action, applicant has realized that still other errors than those specifically enumerated above are corrected in the claims currently pending in this application. Each of these further errors are identified and explained in the accompanying declarations, and are discussed in detail below. To aid in their identification, the same convention for identifying the errors adopted by the Examiner in the Office action has been used.

Error G

As identified by applicant, Error G occurred during the preparation and prosecution of the '947 patent:

> I also erroneously did not present claims to my invention which included the limitation that "said control means further includes means for generating a cue selection signal

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[6]These prior art citations have been submitted in this application in the numerous Information Disclosure Statements which have been considered by the Examiner.

[7]The "channel display designations" could also be defined as being in a "third series".

> corresponding to one of said cues, and wherein said processor means, upon receipt of said cue selection signal reviews the one of said cues corresponding thereto." *JB at 18.*

This omission was the result of oversight by applicant, who further states that "I did not discuss the possibility of presenting one or more claims incorporating this limitation in the applications for the '734 and '947 patents with Mr. Boshinski." *Id.*

Applicants' attorney declares that he too overlooked the inclusion of such claims, and corroborates applicant's statement that the subject was not discussed. *TB at 12.*

This error is based upon applicant erroneously "claiming less than Patentee had a right to claim in the '947 patent" in the sense that too few claims were presented. Thus, similar to Errors F2 and F3 discussed above, this error is properly correctable by reissue.

Error G was discovered during the summer of 1993, while applicant's attorney was drafting claims to be presented in the reissue application then in preparation. Boshinski recognized that the subject matter noted above had erroneously not been presented in any claims of the '734 or '947 patents, although it could have been. *TB at 25.* Accordingly, Boshinski drafted claim 10 to correct Error G. *Id.*

Thus, the time and manner in which Error G was discovered is set forth with adequate specificity in the declarations.

Support for this added limitation may be found in the specification by reference to column 13, lines 18-29.

Error H

As identified by applicant, Error H occurred during the preparation and prosecution of the '947 patent:

> I erroneously did not present claims to my invention which included the limitation that "said memory means includes means for storing, for a plurality of said channel tuning designations, a channel select designation for each of said plurality of channel tuning designations which is identical thereto," nor did I present claims to my invention which included the further limitation that "said multi-channel input includes a plurality of active channels, said memory means including means for storing a channel select designation for each of said active channels which is identical thereto." *JB at 19.*

This omission was the result of oversight by applicant, who further states that "I did not discuss the possibility of presenting one or more claims incorporating this limitation in the applications for the '734 and '947 patents with Mr. Boshinski." *Id.*

Applicants' attorney declares that he too overlooked the inclusion of such claims, and corroborates applicant's statement that the subject was not discussed. *TB at 13.*

This error is based upon applicant erroneously "claiming less than Patentee had a right to claim in the '947 patent" in the sense that too few claims were presented. Thus, similar to Errors F2 and F3 discussed above, this error is properly correctable by reissue.

Error H was discovered around the early part of 1994. As a part of the work in prosecuting applicant's infringement action referred to above, applicant's trial counsel, along with applicant's attorney Boshinski, carefully reviewed numerous prior art citations which were identified by defendants. Trial counsel noted that the fact that the accused device included "means for storing ... a channel select designation for each of said plurality of channel tuning designations which is identical thereto" was helpful in explaining the manner in which applicant's invention worked, and in how it differed from the prior art. Boshinski then realized that claims incorporating this language were not found in either of the '734 or '947 patents, but that such claims could have been presented in the '947 application. *TB at 30.* Accordingly, when the next amendment in this reissue application was drafted in about March through August 1994, claims 18 and 19 were added to correct the Error H. *TB at 32.*

Thus, the time and manner in which Error H was discovered is set forth with adequate specificity in the declarations.

Support for this added limitation may be found in the specification by reference to column 10, lines 53-64.

Error I

As identified by applicant, Error I occurred during the preparation and prosecution of the '947 patent:

> I erroneously did not present claims to my invention which included the limitation that [the memory means is for] "storing at least one operator-assigned channel select designation for *each of a plurality* of said channel tuning designations," and that the processor means is for "clearing from said memory a selected one of said channel select designations and restoring therein said channel select designation for a corresponding one of said channel tuning designations which is identical thereto." *JB at 20.*

This omission was the result of oversight by applicant, who further states that "I did not discuss the possibility of presenting one or more claims incorporating this limitation in the applications for the '734 and '947 patents with Mr. Boshinski." *Id.*

Applicants' attorney declares that he too overlooked the inclusion of such claims, and corroborates applicant's statement that the subject was not discussed. *TB at 14.*

This error is based upon applicant erroneously "claiming less than Patentee had a right to claim in the '947 patent" in the sense that too few claims were presented. Thus, similar to Errors F2 and F3 discussed above, this error is properly correctable by reissue.

Error I was discovered around the early part of 1994 in a manner similar to Error H. As a part of the work in prosecuting applicant's infringement action referred to above, applicant's trial counsel, along with applicant's attorney Boshinski, carefully reviewed numerous prior art citations which were identified by defendants. Trial counsel noted that the fact that the accused device included "means for storing at least one operator-assigned channel select designation for

each of a plurality of said channel tuning designations," and that the processor means is for clearing from said memory a selected one of said channel select designations and restoring therein said channel select designation for a corresponding one of said channel tuning designations which is identical thereto" was helpful in explaining the manner in which the accused device was the same as applicant's invention, and in how the invention differed from the prior art. Boshinski then realized that claims incorporating this language were not found in either of the '734 or '947 patents, but that such claims could have been presented in the '947 application. *TB at 30.* Accordingly, when the next amendment in this reissue application was drafted in around March through August 1994, claims 38 and 39 were added to correct the Error I.[8] *TB at 32.*

Thus, the time and manner in which Error I was discovered is set forth with adequate specificity in the declarations.

Support for these added limitations may be found in the specification by reference to column 10, lines 53-64.

Error J

As identified by applicant, Error J also occurred during the preparation and prosecution of the '947 patent. Error J pertains to applicant's failure to present sufficiently broad language with respect to the expression originally appearing in the claims as "cue". To the extent that this terminology implies a listing of the channels which are contained within the cue, it is unnecessarily narrow. As explained by applicant,

> I did not claim my invention, with respect to the actions of the processor, using the alternate language "scroll sequence" instead of "cue" with regard to channel selection. *JB at 21.*

This error is properly the subject of a reissue application. Although characterized by applicant as a "failure to utilize alternate language," it is in fact a failure to present sufficiently broad

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[8]Claim 39 also addressed Error B.

claim language (in some respects) and is thus similar to errors A, B and C. The error occurred through inadvertence, and is properly presentable in this application for similar reasons.

These claims were not considered, and thus not presented, during the preparation and prosecution of the applications for the '947 and '734 patents by either applicant or his attorney. *JB at 21; TB at 15.* Nor did they discuss the possibility of presenting such claims. *Id.* The claims were omitted through oversight, and the errors occurred, in an ongoing sense, throughout the preparation and prosecution of the applications.

Error J was discovered in about the early portion of 1994. As part of the work in prosecuting applicant's infringement action referred to above, applicant's trial counsel, along with applicant's attorney Boshinski, carefully reviewed the specifications of the '734 and '947 patents, discussing each of the terms used within the specifications. With regard to the term "scroll sequence"[9], trial counsel observed that this term could be interpreted differently than the term "cue" used in the claims of the '734 patent. Boshinski realized the term "scroll sequence" was not found in any of the claims of the '734 or '947 patents, but could have been presented in claims in the '947 application. *TB at 29.* Accordingly, when the next amendment in this reissue application was drafted in around March through August 1994, claims 40-44 were added to correct error J. *TB at 32.*

Thus, the time and manner in which Error J was discovered is set forth with adequate specificity in the declarations.

Error K

Error K, like Error E, pertains to applicant's failure to present sufficiently broad language with respect to the expression originally appearing in the claims as "upon receipt of". To the extent

[9]This term is used in the specification, for example, at Column 13, lines 18-29.

that this terminology implies immediacy in the carrying out of subsequent steps by the processor, it is unnecessarily narrow. As explained by applicant,

> I also did not claim my invention, with respect to the actions of the processor, using the alternate language "following receipt" instead of "upon receipt of" with regard to various input signals to the processor. *JB at 22.*

This error is properly the subject of a reissue application. Although characterized by applicant as a "failure to utilize alternate language," it is in fact a failure to present sufficiently broad claim language and is similar to errors A, B and C. The error occurred through inadvertence, and is properly presentable in this application for similar reasons.

These claims were not considered, and thus not presented, during the preparation and prosecution of the applications for the '947 and '734 patents by either applicant or his attorney. *JB at 22; TB at 16.* Nor did they discuss the possibility of presenting such claims. *Id.* The claims were omitted through oversight, and the errors occurred, in an ongoing sense, throughout the preparation and prosecution of the applications.

The time and manner in which this error was discovered is set forth in the declarations. As explained in the Boshinski declaration, in about the early portion of 1994, the defendant in the litigation which applicant was prosecuting in connection with the '734 patent suggested that the accused device did not fall within the claim language "upon receipt of." This was allegedly because defendant's device received input signals for some of its operations from its operator-actuated control means, but the processor did not carry out the instructions until sometime later. While applicant did not then, and does not now, believe that the argument advanced by defendants was correct, applicant and his attorney nonetheless recognized that broader claim language could have been presented in the '947 patent. The specific language reflected in claims 45-47 is an alternate approach to that taken in claims 17-19, 21-28 and 43 in that the language "following receipt of" is used. *TB at 28.* Also, these claims are dependent claims based upon claim 9 of this reissue application and thus the elements are in a reversed order. Claims 45-47 were drafted during about March through August 1994 as part of a response to an outstanding office action in this application to correct Error K. *TB at 32.*

Thus, the time and manner in which Error K was discovered is set forth with adequate specificity in the declarations.

Support for the language of these claims may be found in the specification by reference to column 13, lines 48-60 and in column 14, lines 13-37 and lines 42-48, as explained above in connection with Error E.

Error L

As identified by applicant, Error L occurred during the preparation and prosecution of the '947 patent:

> I erroneously did not present claims to my invention which included the additional claim element "a television screen", and the limitation "whereby a selected television channel is displayed on said screen." *JB at 23.*

This omission was the result of oversight by applicant, who further states that "I did not discuss the possibility of presenting one or more claims incorporating this limitation in the applications for the '734 and '947 patents with Mr. Boshinski." *Id.*

Applicants' attorney declares that he too overlooked the inclusion of such claims, and corroborates applicant's statement that the subject was not discussed. *TB at 17.*

This error is based upon applicant erroneously "claiming less than Patentee had a right to claim in the '947 patent" in the sense that too few claims were presented. Thus, similar to Errors F2 and F3 discussed above, this error is properly correctable by reissue.

Error L was discovered during the latter part of 1993. As a part of the work in prosecuting applicant's infringement action referred to above, applicant's trial counsel, along with applicant's attorney Boshinski, carefully reviewed numerous prior art citations which were identified by defendants. Trial counsel noted that the fact that the selected channels were displayed on a television screen was helpful in explaining the manner in which applicant's invention worked, and in how it differed from the prior art. Boshinski then realized that claims incorporating this

language were not found in either of the '734 or '947 patents, but that such claims could have been presented in the '947 application. *TB at 30.* Accordingly, when the next amendment in this reissue application was drafted in about March through August 1994, claim 48 was added to correct the error L. *TB at 32.*

Thus, the time and manner in which Error L was discovered is set forth with adequate specificity in the declarations.

Support for this added limitation may be found in the specification by reference to column 4, line 59.

Error M

As identified by applicant, Error M occurred during the preparation and prosecution of the '947 patent:

> I erroneously did not present claims to my invention which included a method in which "said step of generating said first control output signal is performed by a first person, and wherein said step of generating said second control output signal is performed by a second person," and in which "said step of generating said first control output signal is performed by a first person, and wherein said desired channel select designation is predetermined by a second person." *JB at 24.*

The omission of claims incorporating these limitations[10] was the result of oversight by applicant, who further states that "I did not discuss the possibility of presenting one or more claims incorporating these limitations in the applications for the '734 and '947 patents with Mr. Boshinski." *Id.*

Applicants' attorney declares that he too overlooked the inclusion of such claims, and corroborates applicant's statement that the subject was not discussed. *TB at 18.*

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[10]See also the discussion concerning Error A, relating the omission of method claims generally.

This error is based upon applicant erroneously "claiming less than Patentee had a right to claim in the '947 patent" in the sense that too few claims were presented. Thus, similar to Errors F2 and F3 discussed above, this error is properly correctable by reissue.

Error M was discovered during the latter part of 1994. As a part of the work in prosecuting applicant's infringement action referred to above, and particularly as a result of a summary judgement hearing which took place in October 1994, considerable attention was paid during this time to the fact that in the accused device, channel select designations might be chosen by someone other than the operator using the device to control the television receiver. As a result of these discussions, Boshinski realized that although discussed in the specification, there was nothing in the claims which related to various operations of the device being carried out by different persons. He realized that this could be addressed through dependent method claims. Accordingly, while drafting a response to an office action in November and December 1994, Boshinski recognized that specifically claims 55 and 56 could have been presented in the '947 application, but were not, due to Error M. *TB at 34.* These claims were then added by amendment.

Thus, the time and manner in which Error M was discovered is set forth with adequate specificity in the declarations.

Support for these added limitations may be found in the specification by reference to column 13, line 31 through column 14, line 9.

Summary of Claim Errors

For the convenience of the Examiner, the specific errors addressed by each of the pending claims in this reissue application can be summarized as follows:

Claim 5:	Error A	Claim 8:	Error C
Claim 7:	Error B	Claim 9:	Error C

Claim 10:	Error C, G
Claim 11:	Error B
Claim 12:	Error B
Claim 13:	Error B
Claim 14:	Error B
Claim 15:	Error B
Claim 16:	Error C
Claim 17:	Errors B, E
Claim 18:	Errors B, E, H
Claim 19:	Errors B, E, H
Claim 21:	Errors C, E
Claim 22:	Errors C, E
Claim 23:	Errors B, E
Claim 24:	Errors B, E
Claim 25:	Errors B, E
Claim 26:	Errors B, E
Claim 27:	Errors B, E
Claim 28:	Errors C, E
Claim 30:	Errors B, F1
Claim 31:	Errors C, F1
Claim 32:	Errors C, F1
Claim 33:	Errors B, F1
Claim 34:	Errors B, F1
Claim 35:	Errors B, F1
Claim 36:	Errors B, F1
Claim 37:	Errors C, F1
Claim 38:	Error I
Claim 39:	Errors B, I
Claim 40:	Error J
Claim 41:	Error H, J
Claim 42:	Errors C, J
Claim 43:	Errors C, E, J
Claim 44:	Error J
Claim 45:	Errors C, K
Claim 46:	Errors C, K
Claim 47:	Errors C, K
Claim 48:	Error L
Claim 49:	Errors B, E, F2
Claim 50:	Errors B, E, F2
Claim 51:	Errors B, E, F2
Claim 52:	Errors B, E, F2
Claim 53:	Errors B, F1, F3
Claim 54:	Errors B, F1, F3
Claim 55:	Errors A, M
Claim 56:	Errors A, M

See generally *TB at 25, 32-34.*

Because all of the changes to the claims pending in this reissue application can be attributed to errors which are properly correctable by reissue, and which are adequately explained in the accompanying declarations, these claims are allowable. "When the statutory requirements are

met, reissuance of the patent is not discretionary..., it is mandatory." *Scripps Clinic v. Genentech Inc., supra*, 18 USPQ2d at 1009.

Errors in the Specification

The examiner further suggests in the office action that the changes to the specification do not correct errors. However, as explained at the interview, each of these changes are to correct errors which were inadvertently made as the application was being prepared. *TB at 2, 21*. The specific changes of "display code" to "select code" can be seen as directed to error by review of the remaining portion of each paragraph in which these errors occur.

Thus, with regard to the change at column 10, line 58, the examiner is referred to lines 60-62 where it is clear that the reference is to the selection of channels (i.e., "select codes"). For column 11, lines 38-39 and 39-40, it is clear from line 37 that the reference should be to "select code". For column 12, line 19, the examiner is referred back to line 15 and the reference to "select code". For column 12, line 28 and lines 29-30, the preceding paragraph makes clear that the reference should be to "select code".[11]

Because these errors were inadvertently made without deceptive intent, see *TB at 21*, and how and when they were discovered has been adequately explained, *Id.*, the errors are correctable in this reissue application.

For the foregoing reasons, it is submitted that the reissue declaration and the supporting declaration satisfy the requirements of 35 USC 251 and 37 CFR 1.175. Claims 5, 7-19, 21-28 and 30-56 should therefore be allowed.

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[11]Most of these errors were also corrected in the reexamination of the '734 patent.